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21186 7590 11/14/2007 SCHWEGMAN, LUNDBERG & WOESSNER, P.A. P.O. BOX 2938 MINNEAPOLIS, MN 55402			EXAMINER COLBERT, ELLA	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/240,456
Filing Date: January 29, 1999
Appellant(s): LUNDBERG, STEVEN W.

MAILED

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GROUP 3600

Steven W. Lundberg
Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 08/03/07 appealing from the Office action
mailed 1/26/2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6.070,150	REMINGTON et al	5-2000
5,794,221	EGENDORF	08-1998
WO 96/10235	BROWN	04-1996

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Applicant's Specification does not appear to be in agreement with Applicant's claim limitations. In particular, Applicant's Specification discusses three computer systems: a firm computer system, a fee computer system, and an accounting computer system and then continues by discussing the printing of a check on a printer coupled to a workstation and goes on about a check. Nothing in Applicant's claim limitations have a firm computer system or a fee computer system or a check being printed. Applicant is respectfully requested to point out where the claim limitations to claims 1-16 are found in Applicant's disclosure (Specification).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear in Applicant's claims why the client account is being replenished and why the bill is being paid twice.

Doesn't a client have to replenish his or her own account?

Please find attached to this Office Action a diagram of the interpretation of claim 1 which is very confusing to the Examiner if this is what the invention is in claim 1.

In the first claim limitation, is the computer system the firm computer system?

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 6,070,150) Remington et al, hereafter Remington in view of (W0 96/10235) Brown.

As to claim 1, Remington teaches, a computer-implemented method for managing patent and trademark fees comprising: inputting identification information for a patent or trademark matter of a client of a law firm (i.e. customer) and a requested fee associated with the matter for payment to an agency as data representing the identification information into a computer system. The exchange of information may include identifying information relating to the consumer relating to the products or

services being purchased) (col. 1, lines 36-45 and lines 64-67 and col. 2, lines 1-5); deducting a charge for the requested fee against a client account maintained at least in part by an organization separate from the law firm for the client, the client account initially funded by the client such that the client account has a positive balance (col. 1, lines 25-35); the organization generating a fee invoice to the law firm for the requested fee and transmitting the fee invoice to an accounting computer system used by the law firm (col. 3, lines 9-22 and lines 62-67 and col. 4, lines 1-14 and lines 57-65); and replenishing the client account with funds collected from payment of the client invoice for the requested fee (col. 7, lines 61-67 and col. 8, lines 1-6). It is well known that once a client (customer) account is debited the client (customer) has to add more money to the account to maintain a positive balance in order to avoid extra fees.

Remington failed to teach, generating a client invoice from the accounting computer system including a charge to the client for payment of the requested fee, wherein the payment of the requested fee is used to replenish the client account maintained by the organization, wherein the client invoice corresponds to the fee invoice to the law firm such that payment by the client to the law firm for the client invoice provides funds to replenish the client account. Brown teaches, generating a client invoice from the accounting computer system including a charge to the client for payment of the requested fee, wherein the payment of the requested fee is used to replenish the client account maintained by the organization, wherein the client invoice corresponds to the fee invoice to the law firm such that payment by the client to the law firm for the client invoice provides funds to replenish the client account (Page 7, lines 4-25 and Fig. 2

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(100)). It would have been obvious to one having ordinary skill in the art at the time the invention was made to implement the processing of patent and trademark fees and to modify in Remington because such a modification would allow Remington to have a system for the use of transacting patent and trademark business with the Patent and Trademark Office.

The Examiner takes official notice that it is well known in the art of bill paying and fee collection to replenish the account so that upon payment by the customer the account continually retains a positive balance. This allows for the account to not be charge additional fees or charges and to maintain a balance of equality of a control account in the general ledger (e.g. accounts receivable) and the total balance of all accounts in the subsidiary ledger (e.g. customer accounts).

As to claim 2, Remington teaches, receiving notice of an event for the matter of the client of the firm that will require a second fee associated with the matter for payment to the agency by a due date (a remitting agreement usually contains a date when the payment is due from the customer) (col. 9, lines 39-58) and generating a second client invoice including a charge for the requested fee to pre-fund the account maintained by the organization such that upon payment by the client prior to the due date the account has a sufficient positive balance to cover the second fee (col. 10, lines 3-15).

As to claim 3, Remington teaches, wherein the charge included on the second client invoice for the requested fee is less than the requested fee, the account having a positive balance less than the requested fee (col. 13, lines 21-67 and col. 14, lines 1-

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35). It is well known in the art of billing and fee collection to have the charge included on the second invoice (bill) for the requested fee to be less than the requested fee with the account having a positive balance less than the requested fee. The purpose of the second invoice (bill) for the requested fee to be less than the original requested fee would only be obvious that if the bill were for a lesser requested fee than the originally requested fee the account to would have a positive balance since the originally requested fee is less than the balance in the account.

As to claim 4, Remington teaches, wherein generating the second client invoice comprises generating the second client invoice at an accounting computer system of the firm (col. 15, lines 1-17).

As to claim 5, Remington teaches, generating the charge for the requested fee at a fee computer system of the organization (col. 14, lines 36-57); transmitting data regarding the charge from the fee computer system to an accounting computer system of the firm (col. 15, lines 42-56); and generating the second client invoice at the accounting computer system (col. 16, lines 44-61).

As to claim 6, Remington teaches, wherein receiving notice of the event at an accounting computer system of the firm (col. 11, lines 6-46) and transmitting data regarding the event from the accounting computer system to a fee computer system of the organization (col. 13, lines 33-59).

As per claim 7, Remington teaches, further comprising tracking a payment made by the client as covering one of an already made charge for a requested fee associated with a matter for payment to the agency and a charge to be made for a requested fee

associated with a matter for payment to the agency (col. 13, lines 60-67 and col. 14, lines 1-35).

As per claim 8, Remington teaches, further comprising issuing a refund to the client for regular payment made thereby for charges to be made requested fees associated with a matter for payment to the agency (col. 14, lines 36-57). It is well known in the art to issue a refund to the client for regular payment made for charges to be made to requested fees associated with a payment to an agency. The purpose of the refund to the customer for regular payment for charged for the requested fees is when an over payment is made or when the customer paid the bill in a timely manner.

As per claim 9, Remington teaches, wherein payment made by the client comprises a charging of one of a credit card and a charge card of the client (col. 2, lines 45-67).

As per claim 10, Remington teaches, wherein the charging is automatic (col. 3, lines 54-56, col. 4, lines 66-67, and col. 5, lines 1-10).

As per claim 11, Remington teaches, wherein the one of the credit card and the charge card comprises one of a Visa card, a MasterCard card, an American Express card, an Optima card and a Discover card (i. e. the customer can indicate the account by the "brand" name) (col. 5, lines 11-20).

As per claim 12, Remington teaches, wherein the one of the credit card and the charge card of the client is sponsored by the organization (col. 5, lines 18-20).

As per claims 13, Remington and Brown failed to teach, wherein the one of the credit card and the charge card of the client is issued by the organization. However, the

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Examiner takes Official Notice that it is well known in the art that one of the credit card and the charge card of the client is issued by the organization because if the card is sponsored by an organization it is issued by that organization. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have one of the credit card and the charge card of the client is issued by the organization and to incorporate in Remington because this would allow Remington to have both the credit card and the charge card being used to have the bill invoiced to the same organization that issued the cards.

As per claim 14, Remington and Brown failed to teach, computing interest on a positive balance of the client account to be paid to the client; determining whether on average the client account has a positive balance; and upon determining that on average the client account has a positive balance, providing for no cost issuance of the charge for the requested fee for transmittal to the agency. However, the Examiner takes official notice that it is well known in the billing arts to compute interest on a positive balance of an account to be paid to the client, to determine whether on average the account has a positive balance, and determining that on the average the account has a positive balance, providing no cost issuance of the charge for the requested fee for transmittal to the agency are all accounting functions used in an organization in the reconciling of accounts. It would have been obvious to one having ordinary skill in the art at the time the Applicant's invention was made to include the computerized method of claim 1, computing interest on a positive balance of the account to be paid to the client; determining whether on average the account has a positive balance; and upon

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determining that on average the account has a positive balance, providing for no cost issuance of the charge for the requested fee for transmittal to the agency within the Remington and Brown systems for the motivation stated above, *supra*.

Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 6,070,150) Remington et al, hereafter Remington in view of (W0 96/10235) Brown further in view of (US 5,794,221) Egendorf.

As per claim 15, Remington and Brown failed to teach, transmitting electronically data representing first information regarding the charge for the requested fee from the computer system to a fee computer system maintained by the organization; inputting second information regarding the charge received from an external source as data representing the second information into the fee computer system; and reconciling electronically the data representing the first information regarding the charge with the data representing the second information regarding the charge at the fee computer system. Egendorf teaches, transmitting electronically data representing first information regarding the charge for the requested fee from the computer system to a fee computer system maintained by the organization (col. 5, lines 18-35); inputting second information regarding the charge received from an external source as data representing the second information into the fee computer system (i.e. provider 2 can then send verifying information to one or both of the customer and vendor to indicate that the transaction has been approved) (col. 5, lines 35-37); and reconciling electronically the data representing the first information regarding the charge with the data representing the

second information regarding the charge at the fee computer (i.e. provider 2 can then send verifying information to one or both of the customer and vendor to indicate the transaction has been approved) (col. 5, lines 35-37). It would have been obvious to one having ordinary skill in the art at the time the invention was made to transmit electronically data representing first information regarding the charge for the requested fee from the computer system to a fee computer system maintained by the organization; input second information regarding the charge received from an external source as data representing the second information into the fee computer system; and reconcile electronically the data representing the first information regarding the charge with the data representing the second information regarding the charge at the fee computer system and to modify in the systems of Remington and Brown because such a modification would allow the Remington and Brown systems to have the capability to transmit information about the fee being charged from one computer to another remote computer and to reconcile the account after the charges have been received.

As per claim 16, Remington and Brown failed to teach, generating data representing a fee invoice including the charge at the computer workstation and electronically transmitting the data representing the fee invoice to an accounting system maintained by the firm and generating a firm invoice including the charge at the fee computer system for delivery to the firm.

Egendorf teaches, generating data representing a fee invoice including the charge at the computer workstation and electronically transmitting the data representing the fee invoice to an accounting system maintained by the firm (col. 4, lines 52-67); and

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generating a firm invoice including the charge at the fee computer system for delivery to the firm (col. 5, lines 43-56). Remington, Brown, and Egendorf failed to teach, wherein the client invoice corresponds to the firm invoice such that payment by the client to the firm for the client invoice is used as payment by the firm to the organization for the firm invoice. However, the Examiner takes official notice that it is well known in the art of electronic billing to have the client invoice correspond to the firm invoice such that payment by the client to the firm for the client invoice is used as payment by the firm to the organization for the firm invoice. The purpose is to emulate traditional billing and to provide convenient and correct billing to customers. It would have been obvious to one having ordinary skill in the art at the time of Applicant's invention to include the computerized method of claim 1, wherein the client invoice corresponds to the firm invoice such that payment by the client to the firm for the client invoice is used as payment by the firm to the organization for the firm invoice within the Remington, Brown and Egendorf systems for the motivation stated above, *supra*.

(10) Response to Argument

Argument no. 1: Appellant argues: The subject matter claimed by Applicant (Appellant) is found in the claims as filed, which form part of the specification and also the sections of the Specification noted and the reversal of the subject rejection under Section 112 is hereby requested because Applicant (Appellant) respectfully submits the Specification provides enablement commensurate with the scope of claims 1-16.

Examiner's Response: Applicant's claim limitations do not suggest to a person having skill in the art of billing that what Applicant is trying to invent is a recirculating

retainer because Applicant's Specification discusses three computer systems: a firm computer system, a fee computer system, and an accounting computer system and then continues by discussing the printing of a check on a printer coupled to a workstation and goes discussing a check. Nothing in Applicant's claim limitations have a firm computer system or a fee computer system or a check being printed.

Attached to this Examiner's answer is a drawing interpretation of Applicant's (Appellant's), herein after referenced as Appellant or Appellant's claim 1 which raised the 35 USC 112, first paragraph rejection.

Argument no. 2: Appellant argues: Claims 1-16 were rejected under 35 USC 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Appellant regards as the invention. It is believed the Introductory portion of this amendment (Appeal Brief) explains how the system works with the particular scope of the invention claimed set forth in the claims and the Appellant notes that the invention as claimed may include less particularity as to certain details that are not essential to the general computerized systems and methods taught in Appellant's Specification.

Examiner's Response: As a preliminary matter, the Examiner is referring to the amendment as the Appeal Brief in the response. Appellant is reminded that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Argument no. 3: Appellant argues: Appellant respectfully traverses the rejections of claims 1-14 as being unpatentable over Remington et al. (U.S. Patent no. 6,070,150) in view of Brown (WO 96/10235) because the combination of references fails to teach or suggest all of the claim elements and the problem being solved by the proposed combination of references is not contemplated by the references. These two references further fail to contemplate a firm or functionally similar organization inputting the matter identification and billing information into a computer system, but only contemplate a client's self-initiated online transactions.

Examiner's Response: Appellant's claim limitation does not clearly define who is inputting the identification information for a matter of a client and billing information into the computer system. The Examiner according to the claim limitation can read on the client (customer or any other person) inputting the information of the client and the billing information. The claim limitation has been given the broadest reasonable interpretation. The claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Therefore it is interpreted that Remington teaches this claim limitation as in col. 1, lines 36-45 and col. 2, lines 1-5.

Argument no. 4: Appellant argues: The two references Remington and Brown further fail to contemplate an account maintained by any other organization analogous to the client account maintained separate from the firm in which deposits are made or that is funded to have a positive balance as recited in the claims and the references fail to consider generating an invoice for such services, as neither the services nor account

are present, but further fail to consider calculating a bill payable to the account associated with the client in such a way as the account maintains a positive balance. The combination of references fails to teach or suggest all of the elements of claims 1-14 at least because they fail to contemplate a particular matter of a client of a firm or the arrangement of the law firm, organization, invoicing, and data exchange as presently claimed.

Examiner's Response: Brown discloses generating a client invoice from the accounting computer system including a charge to the client for payment of a requested fee with the fee being used to replenish the customer (client) account by an organization ... on page 7, lines 4-25 and fig. 2 (100). The Examiner interprets the invention as a whole as a business plan and business plans use an accounting procedure to implement the business plan.

Argument no. 5: Appellant Argues: The problems to be solved by the proposed combination of references are not contemplated by the references. The problems to be solved by the proposed combination of references are not contemplated by the references and the problems to be solved by the present inventive subject matter are discussed in the application and include resolving tax issues with regard to paying client fees and expenses, solving law firm cash flow issues, and eliminating ethical issues that can arise from loaning funds to clients and these problems are not found anywhere within the cited references. Thus, it appears that the Office Action is using Applicant's disclosure and claims as a template in combining references or stated otherwise, the Office Action is using impermissible hindsight.

Examiner's Response: The Examiner does not see the following features in Appellant's claim limitations: resolving tax issues with regard to paying client fees and expenses, solving law firm cash flow issues, and eliminating ethical issues that can arise from loaning funds to clients. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). The Examiner did not use Appellant's disclosure and claims as a template for combining references. The Examiner used a degree of common sense and what is well known by the skilled artisan in the art of bill payment.

Argument no. 6: Appellant Argues: Both Remington and Brown do not mention, even once, attorneys, lawyers, legal firms or practices, retainers or attorney invoices or bills nor even the problem of keeping retainers for clients of lawyers and how to replenish them and contrary to the examiner's position taken on page 4, last paragraph of the Office Action, Brown does not teach "generating a client invoice from the accounting system ..." as it does not mention client even one time, a client account, an account maintained independently of the law firm, nor other things it is alleged to teach. The official notice taken on page 5 does not remedy the defect in the alleged teaching, which leaves the rejection short of a prima facie obviousness rejection due to

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the factual error in the examiner's position and also in that there is not motivation shown to combine Remington and Brown, and even if there were, the combined teaching would not result in anything to do with lawyers or retainers for clients, by any wild stretch of the imagination.

Examiner's Response: Remington and Brown are analogous art and attorneys, lawyers, legal firms or practices, retainers or attorney invoices or bills are a design choice and given the broadest reasonable interpretation. The broadest reasonable interpretation is attorneys or lawyers or legal firms or professional services or services or products; and customers or individuals or clients and invoices or bills or debits and credits (accounting).

Argument no. 7: Appellant argues: Egendorf is provided to show the additional elements of claims 15 and 16. However, Egendorf fails to cure the deficiencies of Remington and Brown with regard to independent claim 1 as discussed above, from which claims 15 and 16 depend, directly or indirectly. Egendorf fails to contemplate or even mention anything to do with the practice of law or related accounting and there is no motivation to combine Remington, Brown, and Egendorf and is short of a prima facie case and even if combined Appellant's case would not result.

Examiner's Response: In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally

available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Remington discloses, inputting identification information for a matter of a customer and a requested fee or charge for payment to an agency or company as data representing the identification information into a computer system, deducting a charge for the fee against the customer account maintained by an organization or company separate from the organization or company for the client, replenishing the account with the funds or money collected as set forth on pages 3-4 of the office action and Brown discloses generating the client or customer invoice from an accounting computer (any computer that can perform accounting functions can be used). Appellant acquiesced regarding the official notice simply by implying that it does not overcome the deficiencies of Remington and Brown. The claim limitation where official notice was taken would have been well known by a skilled artisan in invoicing and billing and accounting.


(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


ELLA COLBERT
PRIMARY EXAMINER

Conferees:

Vincent Millin 

Appeal Conference Specialist


Jagdish Patel

Primary Examiner